IV. REMARKS

Status of the Claims

Claims 4-8,11,12, 23-27, 31 and 32 are amended. Claims 1-38 are presented for further consideration.

Summary of the Office Action

Claims 1-3, 9-23, and 28-38 stand rejected under 35USC102(e) on the basis of the cited reference Warmus et al, U.S. Patent No. 6,332,149. Claims 4-8, and 23-27 stand rejected under 35USC103(a) based on the reference Warmus, in view of the cited reference Dickmeyer,et al, U.S. Patent No. 6,413,100. Claims 4-8,11,12, 23-27 and 32-33 stand rejected under 35USC112. The Examiner is respectfully requested to reconsider his rejections in view of the above amendments and the following remarks.

It is believed that the Examiner's objection to claims 32 and 33 under 35USC112 was in error, as it appears that it was claims 31 and 32 respectfully that lacked appropriate antecedent basis. Applicant has amended claims 4-8,11,12,23-27 and 32-33 to correct the lack of antecedent basis.

Discussion of the Cited Reference

The Examiner relies on the reference Warmus to support the rejection based on anticipation and as primary support for the rejection based on obviousness. The reference Warmus is a system which allows the printing of brochures and similar documents with fixed and variable information within the brochure. The fixed information represents information that is the same on each copy of the brochure. The variable information changes from copy to copy, such as the name of an intended recipient of a particular copy. A template file is set up that identifies which pages

contain fixed or variable information. The template file will also designate which area of a page will contain fixed or variable information.

In this manner, Warmus provides a system that allows the printing of multiple copies of a brochure, certain copies of which may have customized information. This is a different problem than the problem to which the subject invention is directed. This application is directed to the problem of a master book file being useable only by the original provider because the software is customized for the particular needs of the content provider (see page 2, line 24 to page 3, line 11 of this application).

The problem attempted to be solved in Warmus is a page file problem and treats the data files on a page by page basis, whereas the solution of the subject invention requires the processing of an entire book file. Warmus results in the customization of individual pages of brochure during printing of multiple copies. In the system of this invention, all of the pages are processed in the same manner while the entire book file is converted to accommodate "solution dependent" needs of a particular provider.

The Examiner has characterized the system of Warmus as follows:

> Moreover, Warmus discloses stripping or converting the template files from variable or fixed information-*converting said book files to have a solution-independent, intermediate format*. These files contain information specifying the positioning of fixed and variable information—*storing solution-independent, intermediate formatted book files along with book identification information*(generic or independent format with information identifying fixed and variable positioning) *as a mastered book*(col. 10, lines 45-67, col. 11, lines 34-44.

In this manner the Examiner seeks to equate somehow, information relating to fixed text and information relating to variable text

as the equivalent of solution-independent, intermediate formatted book files of the claims of this application. The Examiner then, based on the above premise, equates the conversion of the so called "stripped" or "working" files to master PDL files of Warmus as the equivalent of converting the solution-independent, intermediate formatted book files to solution-dependent formatted book files of the claims of this application.

In column 11, lines 10-29 of the reference Warmus, the purpose and use of the stripped working files is explained. Based on this description, applicant submits that the process of Warmus is unrelated to the process and system of this application. The solution-independent and solution-dependent book files of the claims of this application are entirely different than the fixed and variable information page files of Warmus. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. Warmus allows the customization of pages of a book during a printing. This application allows the use of a book file by multiple different end providers. The brochures of Warmus have differing text. The books of this application will have the same text. Accordingly the cited reference Warmus does not support the rejection either based on anticipation or obviousness.

The Issue of Anticipation
It is well settled that a claim is anticipated, "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See CHISOLM, Federal Circuit Guide, Pg. 1221).

The elements of the claim and their function and purpose within the claim must be reviewed in a manner similar to an infringement

12

analysis. If the device described in the cited reference would not infringe if it was later, it will not anticipate if the reference is earlier.

Applying this standard to a system, as called for in the reference Warmus, it is observed that significant elements of the claims are missing.

For example, claim 1 states:

> "b) converting said book files to have a solution-independent, intermediate format;
>
> c) storing solution-independent, intermediate formatted book files along with book identification information as a mastered book;
>
> d) converting solution-independent, intermediate formatted book files to solution-dependent formatted book files to match the needs of a book reproduction system; and
>
> e) reproducing said book from information comprised by said solution-dependent formatted book files."

Equivalent language appears in independent claims 20. Since neither these steps or apparatus to accomplish these steps forms part of the system of the cited reference, the system described therein, would not infringe and therefore, the reference Warmus does not support a rejection based on anticipation. This would also apply to the rejected dependent claims.

The Issue of Obviousness
The above described deficiencies of the primary reference Warmus are not remedied by the proposed combination with the teaching of the reference Dickmeyer.

13

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 2/16/05

Signature: _____
Person Making Deposit

15